

REMARKS

The Office Action mailed December 28, 2004, has levied a restriction requirement alleging that the application embodies two distinct inventions. A first invention is alleged to be embodied by claims 1-9 and 18-25, while a second invention is alleged to be embodied by claims 10-17. Applicants hereby elect claim group II (claims 10-17), with traverse.

Applicants traverse the election for at least the following reasons. First, the Office Action alleges that the metal alloy may be made by annealing, sputtering, or CVD methods. However, no such limitations were placed in claim 1. Consequently, the product obtained according to the method of claim 1 will be that which is claimed in device 10 (and vice versa).

Further, the fact that the application embodies both method and apparatus claims does not automatically make it divisible along those lines. In this regard, the Office Action states that claim 1-9 and 18-25 are drawn to a method, which would be classified in class 438, subclass 125. Likewise, the Office Action states that claims 10-17 are drawn to a device, which would be classified in class 257, subclass 362. Applicants, however, have identified a number of patents classified in class 257, subclass 362 that contain method claims, and likewise have identified a number of patent classified in class 438, subclass 125 directed to devices. In fact, just last week (January 18, 2005), the U.S. PTO issued U.S. Patent 6,844,220. This patent was classified in class 438, subclass 125, and it contains BOTH apparatus and method claims.

In view of the U.S. PTO's history of issuing patents with device claims in class/subclass 438/125 and of issuing patents with method claims in class/subclass 257/362 (and indeed issuing patents in these classes/subclasses having both device and method claims), Applicants submit that it is unfair (and inconsistent with the Administrative Procedures Act), to unduly restrict the claims of the present application along these lines. Further, Applicants submit that a proper

examination of this application will require searching in the same classes/subclasses, for both the method and apparatus claims.


For at least these reasons, Applicants respectfully traverse the restriction requirement.

Again, Applicant provisionally elects (with traverse) the claims of claim group II. Should the Office Action remove the restriction requirement, but maintain the election requirement (as to the species of claim group I), Applicant provisionally elects the species of claims 1-9 for prosecution.

Should Examiner feel that further discussion of the application and the Amendment is conducive to prosecution and allowance thereof, please do not hesitate to contact the undersigned at the address and telephone listed below.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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